



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,170	03/24/2000	Yoram Levanon	1268-094	2252

7590

03/12/2003

Lowe Hauptman Gopstein Gilman & Berner LLP
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 03/12/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/534,170

Applicant(s)
Yoram LEVANON et al.

Examiner
Stephen M. Gravini

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-10-03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 14-21 is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3622

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to an analyzing and sorting method, classified in class 705, subclass 14.
 - II. Claims 14-19, drawn to calculating method, classified in class 705, subclass 1.
 - III. Claim 20, drawn to a system, classified in class 705, subclass 10.
 - IV. Claim 21, drawn to a computer readable medium, classified in class 709, subclass 218.
2. The inventions are distinct, each from the other because of the following reasons:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
3. Inventions of group I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

Art Unit: 3622

shown to be separately usable. In the instant case, the independently claimed invention of group I is not limited to the independently claimed presenting, calculating, and correlating features of group II and has separate utility such as presenting a stimulus to an individual, calculating a profile of the individual based on the determined characteristic values, and correlating a desired task oriented to individuals having a particular characteristic with an individual having a particular characteristic and displaying the desired task to the individual having the particular characteristic. See MPEP § 806.05(d). It would be a burden on the Office to search these separate independent and distinct features now claimed.

4. Inventions of group I and group III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the independently invention claimed group I is not limited to the independently claimed processor and memory features in group III. It would be a burden on the Office to search these separate independent and distinct features now claimed.

5. Inventions of group I and group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

Art Unit: 3622

product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the independently claimed process (group I) for using the computer readable medium product (group II) as claimed can be practiced with another materially different product (i.e. a product not limited to the independently claimed sequence of machine executable instructions and a medium bearing the instructions in machine form found in group IV).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Newly submitted claims 14-21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims contain subject matter that is independent and distinct from the originally filed claimed subject matter and it would be a burden upon the Office to examiner this new independent and distinct claimed invention. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

Art Unit: 3622

prosecution on the merits. Accordingly, claims 14-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

8. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed system does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate information or data content campaign are abstract ideas which can be performed mentally or naturally between persons without interaction of a physical structure. Collecting information is analogous to listening, analyzing and sorting profiles is analogous to thinking of a response based on listening. Amending the claims to include analyzing and sorting “in a computerized database.” is not considered sufficient to overcome a non-statutory subject matter rejection made in a prior Office action because that language does not definitively limit the claimed invention and the term “computerized” could be applied to the non-statutory human thought process. Presenting an appropriate information or data content, claimed as a campaign is analogous to responding to the listened data based on a thought response. Without a change in structure or manipulation of data, the independently claimed steps of collecting information, analyzing and sorting profiles, producing a campaign, and presenting an appropriate campaign do not produce a useful, concrete

Art Unit: 3622

and tangible result. The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement and claims depending from them, are not permitted under 35 USC 101 because it is non-statutory subject matter. Since the dependent claims depend upon the independently claimed subject matter, directly or indirectly, those claims are also rejected as depending upon a claim containing non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recited statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

9. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Newly added subject matter independently claimed as analyzing and sorting data in a computerized database and determining a campaign directed to a cluster profile is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The concept of analyzing and sorting is discussed but not such that one skilled in the art would be able to determine that the inventors had possession of that feature in a computerized database. Likewise, the concept of presenting information is discussed in the specification but not such that one skilled in the art would be able to definitively know that the inventors had

Art Unit: 3622

possession of the feature of determining a campaign directed to a cluster profile. However in order to examine the claims in light of the prior art, examiner will assume that the new subject matter is permissible under the first paragraph of section 112.

10. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly added subject matter independently claimed as analyzing and sorting data in a computerized database and determining a campaign directed to a cluster profile fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is considered that there is not sufficient antecedent basis in the specification for the newly added subject matter. This insufficient antecedent basis is considered indefinite and therefore fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include “the following,” (claims 1 and 8), “said items,” (claims 1, 6, and 7), “said individual emotional orientations,” (claims 1 and 8 - plural first occurrence), “the appropriate,” (claim 1), “the cluster,” (claims 1 and 8 - singular first occurrence), “said potential consumer,” (claims 1 and 6 - singular first occurrence), “the level,” and “the potential consumer,”- singular first occurrence (claim 3), “the number,” and “the possible,” (claim 7). However in order to examine the claims

Art Unit: 3622

in light of the prior art, examiner will assume that the new subject matter is permissible under the second paragraph of section 112.

Claim Rejections - 35 USC § 102

11. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Day et al. (US 5,857,175) or Weinblatt (US 5,515,270) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kramer et al. (US 6,327,574) or Eldering (US 6,298,348) and are rejected under 35 U.S.C. 102(g) as being clearly anticipated by Lanzillo, jr. et al. (US 2002/0032602) or McKinley et al. (US 2002/0044743).

Claim Rejections - 35 USC § 103

12. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinblatt et al. (US 5,515,270). Weinblatt teaches the claimed invention, including the steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement, on the face of the patent. Weinblatt does not expressly show the analyzing and sorting of profiles into the clusters based on individual emotional orientations of survival, growth, and relaxation for producing, determining, and presenting marketing campaigns. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The analyzing and sorting steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the

Art Unit: 3622

claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to analyze and sort profiles having any type of content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Furthermore, the independently claimed marketing campaigns is considered an obvious variation from the prior art disclosure of advertisements. To those skilled in the art presenting an appropriate advertisement is functionally equivalent to a marketing campaign since both achieve the same result in the same manner. It would be obvious to those skilled in the art to substitute the claimed "marketing campaign" for the disclosed "presenting advertisement" in order to produce optimum-effect marketing.

Conclusion

13. This is a continued examination of applicant's earlier Application. All claims, except those drawn to an independent and distinct invention, are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3622

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
March 11, 2003